

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Attorney Docket No. 906346039245
Brian Birrenkott et al.)	
)	
Application No.: 10/712,970)	
)	
Filed: November 13, 2003)	
)	
For: SPRAYING DEVICE WITH)	
INTERCHANGEABLE)	
CARTRIDGE)	
)	
Examiner: Kim, Christopher S.)	
)	
Art Unit: 3752)	
)	
Confirmation No.: 9431)	

REMARKS/ARGUMENTS

Claims At Issue

Claims 1-6 and 8-33 are now pending in the subject application in view of the cancellation of claim 7 herein.

Request for Reconsideration and Withdrawal of Premature Final Rejection

Applicants respectfully submit that a premature final rejection has been entered in the present application. Accordingly, reconsideration and withdrawal of the final rejections set forth in the second Office Action mailed March 2, 2005 are respectfully requested pursuant to Sections 706.07(d) and 706.07(e) of the Manual of Patent Examining Procedure (MPEP).

Specifically, applicants respectfully submit that the final rejection in the second Office Action is inappropriate and is not in keeping with U.S. Patent and Trademark Office standards and procedures as set forth in the MPEP.

For example, Section 706.07 of the MPEP states that:

"Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first Action and the references fully applied; and in reply to this Action, the applicants should amend with a view to avoiding all the grounds of rejection and objection. Switching ... from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter will ... tend to defeat attaining the goal of reaching a clearly defined issue for early termination, i.e., either an allowance of the application or a final rejection.

... present practice does not sanction hasty and ill considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end and not be prematurely cut off in the prosecution of his or her application.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing and that a clear issue between the applicant and examiner should be developed, if possible, before appeal." (Emphasis added).

Furthermore, the following admonitions in Section 706.07(a) MPEP should be noted:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement.

...

A second ... action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." (Emphasis added).

In the prosecution of the present application, responsive to a first Office Action, applicants submitted amendments to the claims in a sincere effort to advance prosecution of the application by overcoming the art cited by the Examiner in his original rejection of the claims. In entering these amendments, applicants were merely seeking to define their invention in claims that would provide them with the patent protection to which they are justly entitled in view of the art of record.

Each of the limitations entered by applicants in response to the first Action should reasonably have been expected by the Examiner since they were all directed to better defining the present spraying devices disclosed in the specification as compared with the then cited prior art. Accordingly, applicants believe that in keeping the provisions of MPEP 706.07, they should be entitled to receive the cooperation of the Examiner to the end of obtaining patent protection to which they are entitled and not be prematurely cut off in the prosecution of their application.

However, to the contrary, in the second Office Action which was made "final", the Examiner withdrew all of the prior art references cited in the first Office Action and substituted two entirely new references which had not previously been relied on or even made of record in the prosecution of the application.

In citing the new art, the Examiner alleged that applicants' amendment necessitated the new ground of rejection presented in the second Office Action and, further, contended that applicants' previous arguments are now moot in view of the new grounds of rejection.

Applicants' respectfully submit that the Examiner's position is not well taken and request reconsideration and withdrawal of the finality of the rejection on several grounds.

First, applicants respectfully disagree with the Examiner's contention that applicants' prior amendment necessitated the new ground of rejection herein. Applicants submit that their previously entered amendments merely clarified the distinctions of the originally claimed spraying devices as compared with the coating and paint spraying devices shown in the art cited by the Examiner in the first Office Action and all of the limitations entered in the amended claims should have been reasonably expected by the Examiner in view of the art he cited.

In this regard, applicants submit that the Examiner's new grounds for rejection were not necessitated by applicants' amendments but, to the contrary, the new grounds for rejection were

necessitated by the fact that the art cited by the Examiner in the first Office Action actually was not on point relative to the spraying devices disclosed and claimed in the present application.

In fact, by withdrawing all of the previously cited prior art in the current Office Action, the Examiner has de facto acknowledged that the previously cited art did not anticipate or render the presently claimed invention obvious. Thus, the Examiner has introduced entirely new references herein in an attempt to substantiate his rejection of the present claims without providing applicants with an opportunity for "a full and fair hearing" of their position for overcoming the new and previously uncited prior art. This new citation of prior art effectively constitutes a new first Office Action although the Examiner contends that it is a Final Rejection.

Applicants submit that such action on the part of the Examiner has prematurely cut off the prosecution of the current application and has denied applicants a full and fair hearing of their position as required by Section 706.07 MPEP.

Another ground supporting applicants request for withdrawal of the final rejection herein is that it should be apparent that a clear issue has not been developed between applicants and the Examiner in the present case. Since the Examiner has switched from one set of references to another in rejecting in successive actions claims of substantially the same subject matter, applicants have not been given a fair opportunity to present their position concerning novelty and unobviousness of the claimed invention over the newly cited prior art although, for the record, applicants have entered extensive remarks hereinafter which clearly demonstrate that the Examiner's present rejection of the claims in the Second Office Action are not well taken and upon proper reconsideration should be withdrawn.

Thus, it is submitted that the final rejection in this case is clearly premature and reconsideration and withdrawal of the finality of the rejection are requested in accordance with

Section 706.07(d) MPEP to enable applicants to have a full and fair hearing of the grounds for determining the patent protection to which they are justly entitled.

Reply to Examiner's Response to Amendment

Applicants object to paragraph 3 of the Office Action wherein it is stated that although the Examiner has withdrawn his objection to the phrase appearing in the claims referring to "the cartridge being oriented such that gravity exerts a downward force on the first liquid", he has somehow reached the unfounded conclusion that this phrase is "considered nothing more than stylistic" and does not further define the claims." Clearly, overlooking this affirmative limitation in the claims is not correct examining practice.

Furthermore, as understood, the Examiner is contending that applicants have conceded that this affirmative limitation is merely stylistic. This position defies logic, all that applicants were saying in their response to the Examiner objection in the first office Action was that there was no need to amend the claims since they already particularly and distinctly defined applicants' claimed invention and that the Examiner's requirement to correct the originally submitted claim language was inappropriate.

Thus, applicants submit that the language appearing in claim 1, for example, that "the cartridge being oriented such that gravity exerts a downward force on the first liquid" is a part of the claim and by definition a limitation on the claim's construction. The MPEP Section 2143.03 requires that all words in a claim must be considered in judging the patentability of that claim against the prior art citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

There is no authority for ignoring claim limitations, and there is no basis for the statement that a limitation is nothing more than stylistic and will not be considered as defining the claims.

Accordingly, it is respectfully submitted that applicants are entitled to a proper consideration of the claimed subject matter herein, not one based on the Examiner's disregard for the legitimate distinguishing language set forth in the claims.

Response to the Rejection under 35 U.S.C. §102(b)

Claims 1-5, 8, 9, 11, 12 14-17, 19-21, 23-25, 27-29, 31-33 are rejected under section 102(b) as being anticipated by Norman, Patent No. 4,878,619 (Norman).

This Final Office Action states that Norman discloses "a spraying device comprising a cartridge 10 and a sprayer body 12. The sprayer body 12 comprising: a conduit 80; a movable valve 82; a manual actuator 76; an orifice 28/34." There is no further analysis other than this recitation of parts.

A rejection under 102 is proper only if each and every element as set forth in the claim is found either expressly or is inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987); Section 2131 MPEP.

Independent claim 1, as well as its dependent claims 2-18, in the subject application includes a number of limitations not set forth or considered in the Examiner's final rejection in violation of Section 2143.03 MPEP. Claim 1 includes the limitation that the cartridge is "oriented such that gravity exerts a downward force on the first liquid". This structural limitation, which has been discussed hereinabove, is not disclosed, taught or suggested in Norman, either expressly or inherently. In fact, Norman teaches a non-gravity feed cartridge of the type which is criticized and distinguished in paragraph 0002 of the present application.

Other limitations set forth in claim 1 concern "a manual actuator positioned in operative relationship with the movable valve structure enabling movement of the valve structure between at least three discrete positions". The actuator 76 of Norman does not enable movement of the valve 82, and valve 82 does not move between three discrete positions. These distinguishing

limitations in the present claims regarding the structure and functioning of applicants' invention are not even addressed in the Final Office Action.

Yet another limitation in the present claims concerns "an orifice disposed in the spraying device for metering a predetermined amount of the first liquid from the cartridge." This structural element also is not disclosed, taught or suggested in Norman. Instead, Norman teaches a metering orifice 42 located in the valve 40 which in turn is located in the cartridge 10 and not in the gun 12. This limitation is also not addressed in the Final Office Action.

Independent claim 19, as well as its dependent claims 20-26, in the present application includes some of the same limitations as claim 1 and in addition includes the limitation "without the need for a dip tube." To the contrary, Norman specifically teaches the use of such a tube 34 and, thus, teaches away from the presently disclosed and claimed invention. This distinguishing characteristic of the presently claimed devices relative to the cited Norman reference is never considered or addressed in the Examiner's Final Office Action.

Independent claim 27, as well as its dependent claims 28-32, also includes the limitation "without the need for a dip tube".

Accordingly, in view of the fact that Norman fails to include each and every limitation of the independent claims 1, 19 and 27, as well as their dependent claims, the rejection under section 102 should be withdrawn and this application containing claims 1-6 and 8-33 should be passed to issue.

Alternatively, the final rejection should be withdrawn since a clear issue as to patentability has not yet been developed in the prosecution so as to bring it to a speedy conclusion. The final rejection is believed to be hasty and ill considered and applicants submit

that they have not yet been given a full and fair hearing as to the Examiner's grounds for rejection.

Response to the Rejection under 35 U.S.C. §103(a)

Claims 10, 13, 18 and 26 are rejected under section 103(a) as being unpatentable over Norman.

To establish a *prima facie* case of obviousness under section 103, there must be some suggestion or motivation to modify Norman and when modified, Norman must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); Section 2142 MPEP.

With regard to claim 10, the Final Office Action states that "Norman discloses the limitations of the claimed invention with the exception of the cartridge being made of flexible plastic. Office notice is given flexible plastic. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have made the cartridge of Norman from flexible plastic to prevent corrosion."

This rejection is ill considered for two reasons. First, the Norman reference does not disclose all of the limitations in dependent claim 10 including the limitations set forth in its parent independent claim 1 as discussed above regarding the rejection under §102 . Second, a statement in the Final Office Action that modification of the prior art to meet the claimed invention would have been within the ability of one skilled in the art is not sufficient to establish a *prima facie* case of obviousness. See *Ex Parte Levengood*, 28 USPQ.2d 1300 (Bd. Pat. App. & Inter. 1993). See also Section 2143.01 MPEP.

Regarding dependent claim 13, the Final Office Action states that: "Norman discloses the limitation of the claimed invention with the exception of the check valve having a duckbill portion and an umbrella portion. Office notice is given a check valve having a duckbill portion and an umbrella portion. It would have been obvious to a person having ordinary skill in the art

at the time of the invention to have replaced the check valve of Norman with a check valve having a duckbill portion and an umbrella portion to provide integral/one-piece check valve."

The above noted issues raised regarding claim 10 are directly applicable to the rejection of claim 13 and are again relied upon to distinguish over the art of record. First, Norman does not include all of the limitations of claims 1, 12 and 13 and second, relying on what one skilled in the art might find obvious is not sufficient to establish a *prima facie* case of obviousness.

The same issues apply in regard to the Examiner's rejections of claims 18 and 26.

Claims 6, 22 and 30 are rejected under section 103(a) as unpatentable over Norman in view of Packard 2,991,939 (Packard).

The Final Office Action states that "Norman discloses the limitations of the claimed invention with the exception of the metering dish." As stated above, Norman does not disclose all of the limitations of the claims and all of the argumentation set forth above in regard to the rejections under §102 is incorporated herein by reference relative to the §103 rejections.

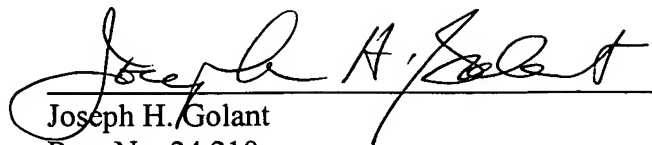
Accordingly, applicants submit that the rejections under 35 U.S.C. §103(a) set forth in the Final Office Action are not well taken and upon reconsideration claims 10, 13, 18 and 26 as well as all of the remaining claims should be passed to issue.

Conclusion

In view of the above cases and MPEP authority, and in view of applicants' Remarks and argumentation, the Examiner is respectfully requested to withdraw the final rejection and promptly pass this case to issue. In the alternative, the Examiner is requested to start the examination procedure afresh so that applicants will be given a full and fair hearing and that a clear issue can be developed as required by the MPEP.

Dated: March 30, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph H. Golant", is written over a horizontal line.

Joseph H. Golant

Reg. No. 24,210

JONES DAY

77 West Wacker Drive

Chicago, Illinois 60601-1692

(312) 269-1534

jhgolant@jonesday.com